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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,689	11/18/2003	Timothy C. Krywanczyk	END920030002US1	4803
26502	7590	11/12/2004	EXAMINER	
IBM CORPORATION IPLAW IQ0A/40-3 1701 NORTH STREET ENDICOTT, NY 13760			RAO, SHRINIVAS H	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,689

Applicant(s)

KRYWANCZYK ET AL.

Examiner

Steven H. Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

The application as currently filed does not claim priority from any prior filed Application. Therefore presently the earliest available filling date is the U.S. filling date namely, Nov. 18, 2003.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 to 20 are, drawn to a UV curable tape used in a semiconductor chip , classified in class 257, subclass 355.
- II. Claims 21-29 are, drawn to a method of making a semiconductor chip, classified in class 438, subclass 116.

Inventions Group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

In the instant case the process as claimed can be used to make other and materially different product, namely a product that does not include the adhesive material recited in claims 1-20.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with William Steinberg (28,540) on October 14, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20.

Affirmation of this election must be made by applicant in replying to this Office action.

Claim 21-29 are withdrawn from further consideration by the examiner, under 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

Acknowledgment is made of receipt of Applicant's Information Disclosure Statement (PTO-1449) filled .

The references on PTO 1499 submitted on 1449 are acknowledged.
All the cited references have been considered.

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The initialed PTO-1449 has been made of record with instructions to the contract staff to mail a copy of the same along with the instant Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(Paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office Actions as of June 200. Paper copies of foreign patents and non-patent literature will continue to be included with Office Actions. These cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants' are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted).

Claim s 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated Moon et al. (WO 92/156651, herein after Moon).

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With respect to claims 1 and 11 Moon describes a UV energy curable tape comprising: a support layer; (Moon page 5 line 30-page 6 line 2) an adhesive material including a UV energy curable oligomer, (Moon Example 1) a UV energy initiator, (Moon page 6 lines 19-28) and a material which emits optical light when said tape is substantially fully cured (Moon page 7 lines 18 to 21) positioned on said support layer. (Moon page 5 lines 30 –page 6 line 2).

With respect to claims 2 and 12, Moon describes the UV energy curable tape of claim 1, wherein said adhesive material comprises an acrylate oligomer. (Moon page 5 lines 8-14).

With respect to claims 3 and 13, Moon describes The UV energy curable tape of claim 1, wherein said UV energy curable oligomer comprises a material capable of reacting with radicals to form longer chain polymers. (Moon page 6 line 28 cross linking- inherent property when molecules cross link they form longer chain polymers/copolymer).

With respect to claims 4 and 14, Moon describes The UV energy curable tape of claim 1, wherein said UV energy initiator comprises photoinitiator. (Moon page 6 line 19) .

With respect to claims 5 and 15 Moon describes the UV energy curable tape of claim 4, wherein said photoinitiator includes diphenyl groups that create radicals when exposed to UV energy. (Moon page 6 lines 19-25).

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With respect to claims 6 and 16 Moon describes the UV energy curable tape of claim 1, wherein said material which emits optical light comprises UV sensitive ink. (Moon page 6 line 20-pigments).

With respect to claims 7 and 17 Moon describes the UV energy curable tape of claim 6, wherein said material which emits optical light comprises from about .001 weight percent to about 20 weight percent of said tape. (Moon claim 6).

With respect to claim 8 and 18 Moon describes the UV energy curable tape of claim 1, wherein said material which emits optical light comprises UV sensitive dye. (Moon page 7 line 20-21).

With respect to claims 9 and 19 Moon describes the UV energy curable tape of claim wherein substantially fully cured comprises the absorption of about 5 millijoules/cmz to about 10 joules/cmz of UV energy into said tape. (Moon page 4 line 10).

With respect to claims 10 and 20 Moon describes the UV energy curable tape of claim 9, wherein said UV energy comprises UV light. (Moon page 1 line 20).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steven H. Rao whose telephone number is (571) 272-1718. The examiner can normally be reached on Monday- Friday from approximately 7:00 a.m. to 5:30 p.m.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956. The Group facsimile number is (703) 308-7724.

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Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven H. Rao

Patent Examiner

October 24, 2004..



LONG PHAM
PRIMARY EXAMINER